

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Mark: BARILLA - AMERICA'S FAVORITE PASTA

Y.

Applicant.

Opposition No.: 91161373

## ANSWER TO NOTICE OF OPPOSITION

Barilla G. E R. Fratelli - Società Per Azioni (hereinafter "Barilla") answers the Notice of Opposition in accordance with the paragraphs of allegation therein.

1. Insufficient information.<sup>1</sup>
2. Barilla has changed its name to Barilla G. E R. Fratelli - Società Per Azioni, with an address at Viale Riccardo e Pietro Barilla 3/ A Parma, Italy; otherwise, admitted.
3. Insufficient information.
4. Insufficient information except admitted that Application Serial Nos. 7,489 and 76/497,190 recite the goods as “pasta” and an alleged date of use prior filing date of the opposed application.
5. Insufficient information.
6. Insufficient information.

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<sup>3</sup>Insufficient information as pleaded herein is shorthand for pleading that applicant is without sufficient knowledge or information with which to form a belief and leaves opposer to its proofs.

7. Admitted to the extent that Barilla filed on June 18, 2002 an application under intent-to-use for the mark BARILLA - AMERICA'S FAVORITE PASTA for "pasta, pasta products, sauces for pasta," in Class 30 and said application was assigned Ser. No. 78/136,703; otherwise denied.

8. Admitted.

9. Admitted to the extent that the file history of the recited application 76/497,489 indicates that the Examining Attorney has cited the opposed application; otherwise, denied.

10. Admitted to the extent that Barilla is the owner by virtue of assignment of U.S. Registration No. 2,005,752; otherwise, denied.

11. Denied.

12. Insufficient information.

13. Denied.

14. Denied.

15. Denied.

16. The allegation is a prayer for relief and requires no response.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense**

Opposer has conceded that AMERICA'S FAVORITE PASTA is not inherently distinctive in connection with its pasta products.

#### **Second Affirmative Defense**

Opposer's alleged AMERICA'S FAVORITE PASTA mark lacks acquired distinctiveness, and the opposition thereby fails to state a claim upon which relief can be granted.

#### **Third Affirmative Defense**

The opposition is barred by the equitable doctrines of laches and/or estoppel.

**Fourth Affirmative Defense**

The alleged trademark AMERICA'S FAVORITE PASTA is misdescriptive of Opposer's goods, which lack the requisite market share to support such claim.

WHEREFORE, Barilla prays that the opposition be dismissed with prejudice.

Respectfully submitted,


By Robert H. Cameron  
G. Franklin Rothwell  
Robert H. Cameron  
Attorneys for Applicant  
ROTHWELL, FIGG, ERNST & MANBECK, p.c.  
1425 K Street, N.W. Suite 800  
Washington, D.C. 20005  
Telephone: (202) 783-6040

answer

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **ANSWER** was served on September 28<sup>th</sup>, 2004, by first-class mail, postage prepaid, on counsel for Opposer:

Thomas H. Van Hoozer, Esq.  
Hovey Williams LLP  
2405 Grand Blvd., Suite 400  
Kansas City, MO 64108

  
Robert DiGiovanni

answer